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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,864	08/28/2003	Chung-Pin Liao	2450-0390P	6384

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EXAMINER

MAI, NGOCLAN THI

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,864

Applicant(s)

LIAO, CHUNG-PIN

Examiner

Ngoclan T. Mai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of group II in the reply filed on 12/14/05 is acknowledged. The traversal is on the ground(s) that there is no burden for the examiner to examine two inventions in a single application. This is not found persuasive because the examination of the two different processes claims requires different search, i.e., there may be some overlap in the searches of the two groups, but there is no reason to believe that the searches would be identical. Furthermore, the examination of different process claims requires additional work. Therefore, based on the additional work involved in searching and examination of the two distinct inventions together that would present serious burden to the examiner, restriction of distinct invention is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-13 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/14/05.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no description of the limitation of claim 16 in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 14 and 19, the phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 14-16, 18, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wootten (U.S. Patent No. 4,124,338).

Wootten discloses a method for preventing fouling and corrosion utilizing technetium-99. Wootten teaches that the growth of organism on the surface of a substrate in contact with water is prevented while simultaneously preventing corrosion of the substrate by depositing technetium-99 on the metal substrate such as ship hull, col. 1, lines 52-54. The technique for depositing can be electroplating and electro-deposition, col. 2, lines 20-25, spray coating, col. 3, lines 51-64, diffusion coating, col. 3, lines 65-68.

As for claim 16, Wootten teaches metal spraying Te-99 powder on the substrate for providing the protection. Wootten teaches the thickness of the coating on the substrate is ranging from 0.5 to 2.5 mil (col. 3, lines 33-40), which is equivalent to (12.7 to 63.5 microns). Since the maximum diameter of a powder cannot be higher than the thickness of the powder used in the coating, the beta-emitter powder taught by Wootten inherently has particle diameter or size less than the thickness of the coating. Thus the beta-emitter powder would have a diameter encompassing the claimed beta-emitter powder.

8. Claims 14-15, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (U.S. Patent No. 5,011,708, now Kelly).

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Kelly discloses a method for preventing the growth of microorganisms on the surface of a substrate in contact with the environment, which contains microorganism, while simultaneously preventing corrosion of the substrates by depositing nickel-63 onto the substrates. The substrate can be metal or non-metal such as cast iron, mild steel, stainless steel, aluminum, concrete, wood and various plastics, col. 1, lines 19-27.

As for claim 18, the technique for depositing can be any technique well known in the art, such as electro-plating, electro-deposition and diffusion alloying (corresponding to applicant's diffusion coating), col. 3, lines 51-56.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Nara et al. (U.S. Patent No. 6,312,571, now Nara).

The difference between the claim and Kelly is that Kelly does not teach the coating material is nitric acid.


Nara discloses a method of coating nickel on a substrate to prevent the substrate from corrosion by dissolving nickel material in nitric acid, col., 3, line 11-17 and col. 3, line 65 to col. 4, line 6. Thus it would have been obvious to one of ordinary skill in the art to deposit Ni-63 onto the substrate taught by Kelly by the method well known the art such as the one disclosed by Nara.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ngoclan T. Mai
Primary Examiner
Art Unit 1742

n.m.